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| 10/561,268 | 12/19/2005 | Daniel Charles Underwood | 01594.002100. | 6539 |
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| FITZPATRICK CELLA HARPER & SCINTO | | | MACARTHUR, VICTOR L. | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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|------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/561,268 | Applicant(s) UNDERWOOD, DANIEL CHARLES |
| | Examiner VICTOR MACARTHUR | Art Unit 3679 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 23 November 2009.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,2,6-14,16-18 and 27-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,2,6-14,16-18 and 27-29 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 2/19/2009 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____
- 5) Notice of Informal Patent Application
- 6) Other: _____

DETAILED ACTION

Drawings

The drawings were received on 11/23/2009. These drawings are acceptable for the purposes of examination, but further objected to as follows:

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “upstanding land with a loop section seat extending around the upstanding land” (claims 1 and 2) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Every element recited in the claims must be described in the written description with reference characters regarding the drawings; or those features must be deleted from the claims. i.e., the “upstanding land with a loop section seat extending around the upstanding land” (claims 1 and 2).

Claim Objections

Claims 1 and 2 are objected to because of the following informalities:

- The phrase the “upstanding land with a loop section seat extending around the upstanding land” (claims 1 and 2) are not recited in the specification. Furthermore, it is unclear which drawing elements, if any, are represented by the above-mentioned phrases.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 2, 6-14, 16-18 and 27-29 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to

reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has not pointed out where the amended claims are supported, nor does there appear to be a written description of the following claim limitations in the application as filed such that these newly added limitations constitute new matter:

- “an upstanding land with a loop section seat extending around the upstanding land”
(lines 5-6 of claim 1, and lines 14-15 of claim 2).
- “transversely extending mating sliding surfaces adapted to mate, by which the retainer and seat section are progressively secured together by sideways sliding engagement of the mating sliding surfaces” (lines 7-9 of claim 1)
- “the seat section and the retainer having transversely extending mating sliding surfaces adapted to mate, by which the retainer and seat section are progressively secured together by sideways sliding engagement of the mating sliding surfaces”
(lines 7-9 of claim 2).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, 6-14, 16-18 and 27-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The limitation “the upstanding land with a loop section seat extending around the upstanding land” (claims 1 and 2) is unclear. How can applicant’s seat 13 be taken to extend around lands 15 and 16 as described in the specification and shown in the drawings? It appears that no elements extend completely around elements 15 and 16 much less element 13.

The term “progressively” as used in claims 1 and 2 is unclear. How are progressively secured elements structurally different from non-progressively secured elements? Note that the written description does not set forth any antecedent basis for this limitation.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 6-14, 16-18 and 27-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Bazeley (U.S. Patent 1,672,867).

At the outset the examiner notes that “the reinforcing bar 11 does not constitute part of the present invention” (applicant’s specification, p.4, ll.14-15).

Bazeley discloses (in atleast figs.8-10) all of the applicants “reinforcing bar connector assembly” structure to include a body (A) having a bar seat section (seat section of A); and a bar retainer (B) moveable transversely (note that the term transverse is taken to mean “acting, lying or being across” in accordance with Merriam-Webster’s Collegiate Dictionary Tenth Edition) relative to the seat section, the seat section having an upstanding land (land of A receiving B)

with a loop section seat (loop section seat of land) extending around (in as much as applicant's own invention does) the upstanding land, the seat section and the retainer having transversely extending mating sliding surfaces (surfaces of A and B that slide against one another during installation of B into A) adapted to mate, by which the retainer and seat section are progressively secured (in as much as applicant's invention is) together by sideways sliding engagement of the mating sliding surfaces and the retainer being transversely moveable relative to the bar seat section between a first position (removed position) and a second position (inserted position).

Note that the other embodiments shown in figures 1-7 and 11-15 also read on applicant's claims within the broadest reasonable interpretation of the claim language.

Because the prior art structure is substantially identical to the claimed structure the PTO must presume claimed functions/properties to be inherent, thus presenting a *prima facie* case and properly shifting the burden to prove otherwise with evidence to the applicant. It is fairly the applicant's burden to obtain and test the prior art since the Patent Office is unable to manufacture or obtain prior art products. Mere allegation that the prior art does not inherently posses applicant's claimed functions/properties is not sufficient without actual evidence proving as much. See the following:

MPEP §2112.01 (I);

MPEP §2114;

In re Ludtke, 441 F.2d 660, 664, 169 USPQ 563, 566 (CCPA 1971);

In re Brown, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972);

In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977);

In re King, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986);

In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed.Cir. 1990);

In re Schreiber, 128 F.3d 1473, 1478 44 USPQ2d 1429, 1432 (Fed.Cir.1997)

Claims 1, 2, 6-14, 16-18 and 27-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Simons (U.S. Patent 271,141).

At the outset the examiner notes that “the reinforcing bar 11 does not constitute part of the present invention” (applicant’s specification, p.4, ll.14-15).

Simons discloses all of the applicants “bar connector” structure to include a body, a bar seat section and bar retainer.

Because the prior art structure is substantially identical to the claimed structure the PTO must presume claimed functions/properties to be inherent, thus presenting a *prima facie* case and properly shifting the burden to prove otherwise with evidence to the applicant.

Response to Arguments

Applicant's arguments with regard to the claim rejections have been fully considered but they are not persuasive.

Applicant argues that claims 1 and 2 are not include new matter stating that "one of ordinary skill in the art would recognize the progressive securing together of the retainer and seat section by sideways sliding engagement of the mating sliding surfaces, especially when tapered surfaces are used". This is not persuasive as follows:

- Applicant has failed to point out where the original specification details the limitation "progressively".

- Applicant's argument that one of ordinary skill would recognize that "progressively secured" elements would be beneficial is irrelevant to the question of whether or not applicant's originally filed specification contained such matter. To use an analogy, one of ordinary skill might recognize that duct tape is beneficial for holding parts together, however that says nothing about whether duct tape was set forth in applicant's original specification. Furthermore, why would applicant attempt to obtain patentability based upon a limitation so well known to one of ordinary skill that the subject matter need not even be present in the originally disclosed invention? Wouldn't such a well known limitation, that requires not original description by applicant, be infinitely obvious to one of ordinary skill?
- Applicant has provided no actual evidence that "progressively secured" was present in the original specification. MPEP §716.01(c)(II) states "The arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965)."

Applicant argues that claims 1 and 2 are not unclear since one of ordinary skill would understand the limitation. This is not persuasive as follows:

- Applicant has failed to point out where the limitation is described in the specification (original or otherwise).
- Applicant has failed to identify how elements "progressively secured" are structurally different from elements that are "non-progressively secured" such that it appears that even applicant is unclear as to the exact structural scope of the limitation.

Applicant argues that the newly added limitation “upstanding land with a loop section seat extending around the upstanding land”. This is not persuasive since the limitation is new matter, unclear and present in the prior art in as much as it is present in the originally disclosed invention. See rejections detailed above.

Applicant argues that the limitation of "a retainer being wedged between bars". This is not persuasive since the claims are drawn to a connector assembly merely intended for use with bars such that the bars do not structurally limit the assembly itself. See applicant's specification which states "the reinforcing bar 11 does not constitute part of the present invention" (applicant's specification, p.4, ll.14-15). Furthermore, as detailed in the rejections above the prior art sets forth all of applicant's claimed connector assembly structure (connector assembly having a body, bar seat section, and a bar retainer etc.). As of yet, applicant has failed to submit any evidence, much less proof, that the prior art structure is incapable of performing the claimed functional intended use with a reinforcing bar. If applicant wishes to structurally limit the claimed connector assembly to structurally include a reinforcing bar then the claims must be amended accordingly (i.e., by replacing "being adapted to receive" with --receiving-- in line 4 of claim 1, etc.") and appropriately amending the written description. Also note the following:

- MPEP §2112.01 (I) states “When the structure recited in the reference is substantially identical to that of the claims, claimed properties or functions are presumed to be inherent... [and] a *prima facie* case of either anticipation or obviousness has been established” (emphasis added);
- MPEP §2114 states “Apparatus claims must be structurally distinguishable from the prior art... [and the] Manner of operating the device does not differentiate apparatus

- claim from the prior art... [and a] claim containing a 'recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus' if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987)" (emphasis in original).
- "Where, as here, the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product. See *In re Ludke, supra*. Whether the rejection is based on 'Inherency' under 35 USC 102, on '*prima facie* obviousness' under 35 USC 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the PTO's inability to manufacture products or to obtain and compare prior art products. See *In re Brown*, 59 CCPA 1036, 459 F.2d 531, 173 USPQ 685 (1972)" (emphasis added) *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977);
 - "Apparatus must be distinguished from the prior art in terms of structure rather than function." *In re Schreiber*, 128 F.3d 1473, 1477-78 44 USPQ2d 1429, 1431-32 (Fed.Cir.1997)
 - "Apparatus claims cover what a device is, not what a device does." See *Hewlett-Packard Co. v. Bausch & Long Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990)

- “[I]t is elementary that the mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art. Additionally, where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.”
(emphasis added) *In re Swinehart*, 58 CCPA --, --F.2d --, 169 USPQ 226 (1971), and *In re Ludtke*, 441 F.2d 660, 664, 169 USPQ 563, 566 (CCPA 1971);
- “[I]t is the patentability of the product claimed and not of the recited process steps which must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith.” (emphasis added) *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972);
- "Contrary to appellant's reasoning, after the PTO establishes a *prima facie* case of anticipation based on inherency, the burden shifts to appellant to prove that the subject matter shown to be in the prior art does not posses the characteristic relied on... Here, appellant's burden before the board was to prove that Donley's structure

- does not perform the so-called method defined in the claims when placed in ambient light. Appellant did not satisfy that burden, it did not suffice merely to assert that Donley does not inherently achieve enhanced color through interference effects, challenging the PTO to prove the contrary by experiment or otherwise. The PTO is not equipped to perform such tasks.” *In re King*, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986);
- “Spada was reasonably required to show that his polymer compositions are different from those described by Smith. This burden was not met by simply including the assertedly different properties in the claims. When the claimed compositions are not novel they are not rendered patentable by recitation of properties, whether or not these properties are shown or suggested in the prior art.” *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).
 - MPEP §716.01(c)(II) states “The arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965).”

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor MacArthur whose telephone number is (571) 272-7085. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

February 22, 2010

/Victor MacArthur/
Primary Examiner, Art Unit 3679